

REMARKS

Claims 3 and 7 have been rewritten in independent form. Springs 31 and 36 are provided in Last to restrain or center a pendulum of a generator which is carried inside an oceanographic research buoy. Last does not suggest that its springs could be utilized in other types of generators and in particular lever type generators of Woodbridge or the present invention having a float attached to one end and a magnet attached to the other. Thus, it should be appreciated that Woodbridge does not suggest that it is deficient or that further improvement is possible by including resilient means. Last does not suggest that its springs could be utilized in the lever type generator of Woodbridge. Thus, only the hindsight knowledge of the present invention provides the necessary suggestion of utilizing resilient means in a lever type generator (and discarding the other elements of Last necessary for operation of the generator taught therein). Thus, it is respectfully submitted that the rejection of claims 3 and 7 has been overcome. Favorable reconsideration is respectfully requested.

Claim 3 and 7 have been amended to further define the present invention in a manner to prevent the reading thereof in the manner contended by the Examiner and to distinguish over the prior art. Specifically, the direction of movement of the magnet in Woodbridge and Last coincides with the direction of the stator, i.e. the magnetic line. To avoid the magnet impacting the stator in the movement, there must be an air gap between the magnets and the stators to maintain a smooth movement. The bigger the swing of the magnet is, the larger the air gap is required. On the other hand, the direction of movement of the magnets in the present invention is vertical to the direction of the magnetic line, please refer to fig. 1 and 2 of the present invention, the air gap in the magnetic circuit is very small so as to decrease the total magneto-resistance of the magnetic circuit and increase the efficiency. Thus, it is respectfully submitted that the rejection of claims 3 and 7 has been overcome for this separate and independent reason. Favorable reconsideration is respectfully requested.

With regards to claims 4 and 8 and as set forth at least at page 7, line 7 and following of the present application, the second coils are provided to allow use of an electromagnet and not for duplication of the first coils. Thus, the St. Regis decision is not applicable. Further, as stated by the Patent Office Board of Appeals in *Ex parte Dere*, 118 U.S.P.Q. 541 (1957) at page 544:

It will be observed that the last sentence of the above quotation is a concession that the art contains no suggestion of having marked zones of perforation on opposing edges spaced according to the metric or English systems respectively. The examiner, as to this relationship, which is the very thing that

yields the useful results already pointed out merely states it:

‘is not seen to provide a patentable distinction, being no more than a matter of choice.’

Why he so holds he does not say and we do not see particularly since only the disclosure of the instant case makes a ‘choice’ available.

In view of the fact that claimed relationship has the useful advantages already enumerated, we cannot agree with this undocumented statement.

Also, as stated in the report by the Subcommittee on Quality of Examination on page 323 of the January, February and March 1990 edition of the AIPLA Bulletin:

Are the Examiners even attempting to search for what they regard as “mere matters of design choice.” Federal Circuit decisions such as *In re Newell*, No. 89-1332 (Fed. Cir. Dec. 12, 1989) and *In re Kaplan*, 229 U.S.P.Q. 678, 683 (Fed. Cir. 1986), show that the Federal Circuit has recognized the problem and will insist on the citation of relevant art. A rejection based on “mere design choice” should be supported by the prior art.

Particularly, as set forth in *In re Kaplan*, 229 U.S.P.Q. 678, 683 (Fed. Cir. 1986):

In the later case [a mere variation of that invention which would have been obvious to those of ordinary skill in the relevant art], there must be some clear evidence to establish why the variation would have been obvious which can properly qualify as “prior art.” Even if obviousness of the variation is predicated on the level of skill in the art, prior art evidence is needed to show what that level of skill was. (Bracketed material and emphasis added.)

It is respectfully submitted that the prior art does not in any way support that applicant’s use of the same material to form the magnet and the stator core is within the level of ordinary skill in the art. The only suggestion of the recited construction and arrangement is the hindsight knowledge of the present invention. The Examiner has not provided any prior art evidence supporting his contention, with such evidence being indicated by the Court of Appeals for the Federal Circuit as being needed to support the present rejection. It is then respectfully submitted that the Examiner must present prior art evidence showing that the modifications that the Examiner apparently concedes are not suggested by the references applied in this official action would be a “choice” to a person skilled in the art.

It is then respectfully submitted that the rejection of claims 4 and 8 has been overcome for this separate and independent reason. Favorable reconsideration is respectfully requested.

The Examiner has cited the United States patents listed in NOTICE OF REFERENCES CITED as A-J, L and M of Page 1 of 2, and A, B and D of Page 2 of 2. By the lack of application of these references and others like them within the classes or subclasses searched, the Examiner apparently recognizes the clear patentability of the present invention over any of these references.

Therefore, since the claims of the present application have been shown to include limitations directed to the features of applicant's apparatus for converting ocean wave energy into electric power which are neither shown, described, taught, nor alluded to in any of the references cited by the Examiner, whether those references are taken singly or in any combination, the Examiner is requested to allow claims 3, 4, 7 and 8, as amended, of the present application and to pass this application to issue.

Respectfully submitted,

Jwo-Hwu Yi



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